The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STEVEN R. TUGENBERG, DOUGLAS A. HARDY and THOMAS E. TKACIK

Appeal No. 2005-0362
Application No. 09/671,941

ON BRIEF

Before THOMAS, HAIRSTON, and JERRY SMITH, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 19.

Representative claim 1 is reproduced below:

1. A method for purchasing items over a network using a secure communication device, the secure communication device including a host processor, a secure memory that includes a laser-scribed encryption key and a non-secure memory for storing encrypted data, wherein sensitive data is encrypted within the secure memory using the laser-scribed encryption key and stored as encrypted data in the non-secure memory the method comprising the steps of:

retrieving an encrypted credit card number and an encrypted secret key from the non-secure memory;

decrypting the encrypted credit card and secret key with the laser-scribed encryption key;

encrypting the credit card number with a communication encryption key, the communication encryption key being related to the secret key; and

transferring the credit card number, as encrypted with the communication encryption key, over the network to a destination.

The following reference is relied on by the examiner:

Matsushima et al. (Matsushima) 2002/0161722 A1 Oct. 31, 2002

Claims 1 through 19 stand rejected under 35 U.S.C. § 102(e)as being anticipated by Matsushima.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief as to appellants' positions, and to the answer for the examiner's positions.

OPINION

We reverse.

Matsushima is a published U.S. application bearing a publication date of October 31, 2002, which is after the present application's filing date of September 27, 2000. Matsushima bears a PCT filing date of January 12, 2001 and is also a continuation-in-part (CIP) of a prior U.S. application 09/482,521, filed January 14, 2000. It is thus apparent that the examiner relies upon the filing date of January 14, 2000 as the basis on which to assert anticipation of the present claims on appeal.

Pages 3 through 6 of the answer set forth a detailed correspondence of the present claims on appeal to the disclosure of Matsushima. This correlation has not been challenged by appellants in the brief and reply brief. Appellants' basic position urging reversal of the present rejection under 35 U.S.C. § 102(e) is that the examiner has not asserted a prima facie case of anticipation since the examiner essentially has not established that the January 14, 2000 date of the parent application to Matsushima, on which the examiner relies, actually

proves anticipation of the presently claimed subject matter within this statutory provision. We agree.

Within 35 U.S.C. § 102 per se, a patent applicant is entitled to a patent unless the examiner is able to prove that the invention was described in an application for patent, published under 35 U.S.C. § 122(b), by another in the United States before the invention of the applicant for the patent. Even though the examiner has provided a correlation of each of the claimed elements in the present claims on appeal to the subject matter in Matsushima itself, the appellants argue, and we agree since the same situation applies to us, that the examiner has provided no evidence as to what material of the parent application filed on January 14, 2000 of Matsushima was carried over to or in common with the present CIP version of Matsushima. Only the subject matter that was common between the two applications is available to prove anticipation. Note the analysis provided in MPEP § 2136.02 and § 2136.03(IV).

The examiner's apparent continued reliance in this record on the examiner's limited review of the parent application to Matsushima and the assertion that the examiner has found support

for the claimed features relied upon by the examiner in the parent application is not sufficient evidence to prove anticipation. It is perplexing to understand from page 7 of the answer that the examiner asserts that the examiner has reviewed the parent application of Matsushima, yet he also asserts that it is not readily available to the examiner. The examiner's condition there that appellants may order a copy of the abandoned parent application to Matsushima does not fulfill the examiner's own burden to prove anticipation within 35 U.S.C. § 102. As indicated earlier, it is the examiner who has the burden under 35 U.S.C. § 102 to prove unpatentability and it is not, in effect, appellants' burden to prove patentability. The examiner must affirmatively assert and prove to appellants and to us the nature of or facts and circumstances surrounding the assertion of anticipation and not to shift the burden to appellants to prove the opposite.

Therefore, since there is no evidence in the record for us to review that the parent application to Matsushima provides support that is common with the present CIP version of this

reference, the rejection of claims 1 through 19 on appeal under 35 U.S.C. § 102(e) is reversed.

On the other hand, from our perspective, under the present facts and circumstances, the examiner is free to reinstitute the present rejection to the extent the examiner is able to provide evidence that the parent application to Matsushima has the subject matter carried over to its present version in the form of Matsushima's CIP that is common with the subject matter of the parent application's filing date of January 14, 2000 that provides anticipatory subject matter of the present claims on appeal.

In view of the foregoing, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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KENNETH W. HAIRSTON)
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